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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

22171.353 (16048ROUS01U)

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on March 25, 2009

Signature

*Bonnie Boyle*

Typed or printed name Bonnie Boyle

Application Number

10/630999

Filed

July 30, 2003

First Named Inventor

Bordin et al.

Art Unit

2416

Examiner

Mattis, Jason E.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☐

attorney or agent of record.

Registration number 59,804

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

*Liem Do*

Signature

Liem T. Do

Typed or printed name

972-739-8643

Telephone number

March 25, 2009

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☐

\*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: Bordin et al.	§	Attorney Docket No. 22171.353
	§	(16048ROUS01U)
	§	
Serial No.: 10/630,999	§	Group Art Unit: 2416
	§	
Filed: July 30, 2003	§	Examiner: Mattis, Jason E.
	§	
For: <b>PROVIDING PACKET-BASED</b>	§	Conf. No. 7723
<b>MULTIMEDIA SERVICES VIA A</b>	§	
<b>CIRCUIT BEARER</b>	§	

**REASONS IN SUPPORT OF**  
**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Mail Stop **AF**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In the Final Office Action mailed January 28, 2009, claims 1, 3-9, and 12-20 were rejected. It is respectfully submitted that the rejections are in clear error and should be withdrawn. Please consider the following reasons in support of the concurrently filed Pre-Appeal Brief Request for Review.

**Reasons**

Applicants respectfully submit that there is clear error with respect to the Examiner's rejection of claims 1, 8, and 15 and the claims that depend therefrom. Claims 1, 8, and 15 were rejected under 35 U.S.C. §102(e) as being anticipated by Forslow (U.S. Patent 6,608,832 hereinafter referred to as "Forslow"). (Final Office Action mailed January 28, 2009, pg. 2). These rejections are respectfully traversed, for the following reasons.

The PTO provides in MPEP § 2131 that

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of

California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). ... “The identical invention must be shown in as complete detail as is contained in the ... claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).  
(emphasis added)

Therefore, to sustain the §102 rejection, Forslow must disclose each and every element in as complete detail as is contained in the pending claims.

With respect to independent claim 1, Forslow does not disclose a method that includes the features of “transferring signaling information for the multimedia service via the packet signaling connection in alignment with the standard” and “transferring data for the multimedia service via the circuit bearer connection in alignment with the standard, wherein the multimedia service is provided to the mobile device via the network as specified by the standard even though the network does not support the required QoS functionality.”

More specifically, the Office Action indicated that Forslow discloses transferring signaling information for the multimedia service via the packet signaling connection in alignment with the standard in “column 6 lines 34-47, column 10 lines 18-39, column 11 line 56 to column 12 line 10, and Figure 7.” (Final Office Action mailed January 28, 2009, pg. 3). Additionally, the Office Action indicated that Forslow discloses transferring data for the multimedia service via the circuit bearer connection in alignment with the standard wherein the multimedia service is provided to the mobile device via the network as specified by the standard even though the network does not support QoS functionality in “column 6, lines 34-47, column 10 lines 18-39, column 11 lines 29-42, column 11 line 56 to column 12 line 10, and Figure 7.” (Final Office Action mailed January 28, 2009, pg. 3). Applicants respectfully disagree.

Forslow specifies that “[i]n the present invention an optimal type of mobile communication network transfer service—a circuit-switched transfer service or a packet-switched transfer—is specified on an individual application flow basis.” (Forslow, Col. 5, lines 41-45) (emphasis added). For example, each individual application flow may have a quality of service request (e.g., predictive quality of service, best effort quality of service, or low delay quality of service). Accordingly, the Forslow reference provides a mechanism that selects either a circuit-switched

bearer or a packet-switched bearer that is best suited to transfer the individual application flow in accordance with its quality of service requirements. (See Forslow, Col. 5, line 66 to Col. 6, line 15). As clearly shown below in Fig. 7 of Forslow, “the present invention provides a bearer selection and quality of service parameter mapping layer which selects for each application flow at the IP layer the best suited one of a circuit-switched bearer and a packet-switched bearer.” (Forslow, Col. 12, lines 14-18) (emphasis added).

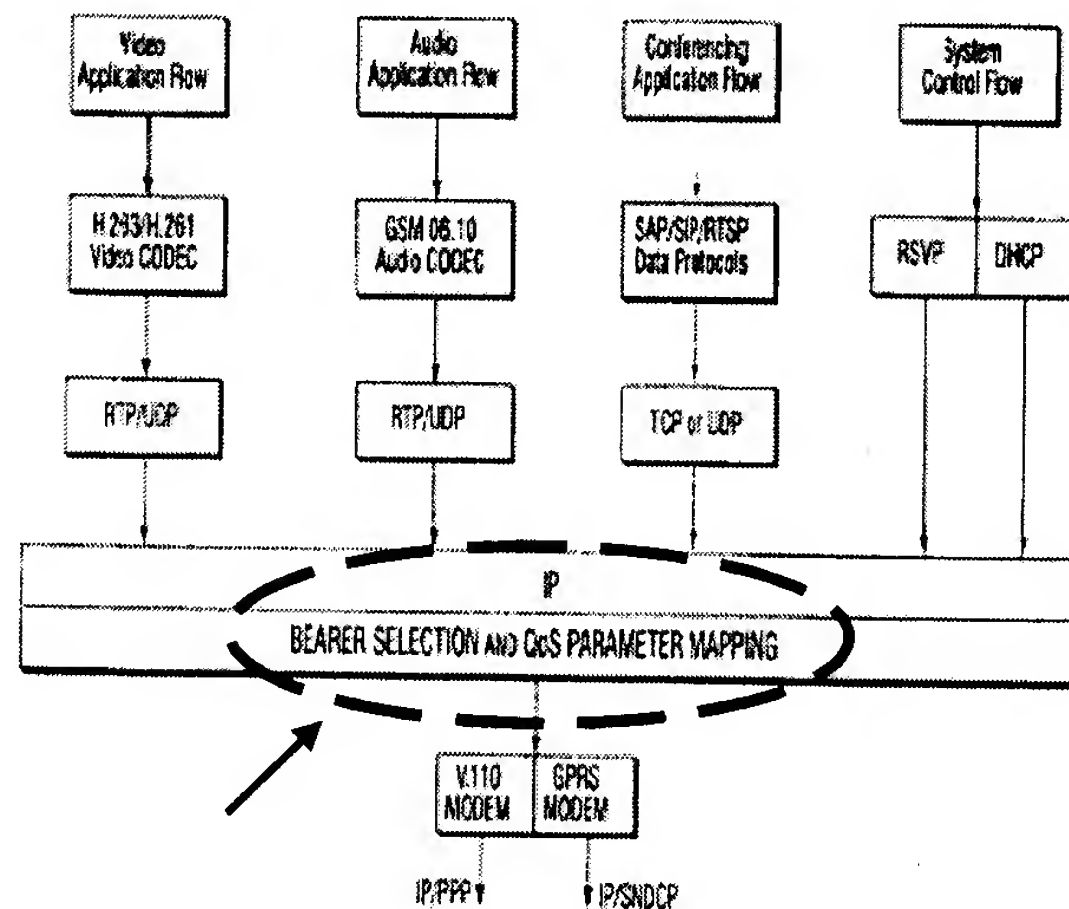


Fig. 7

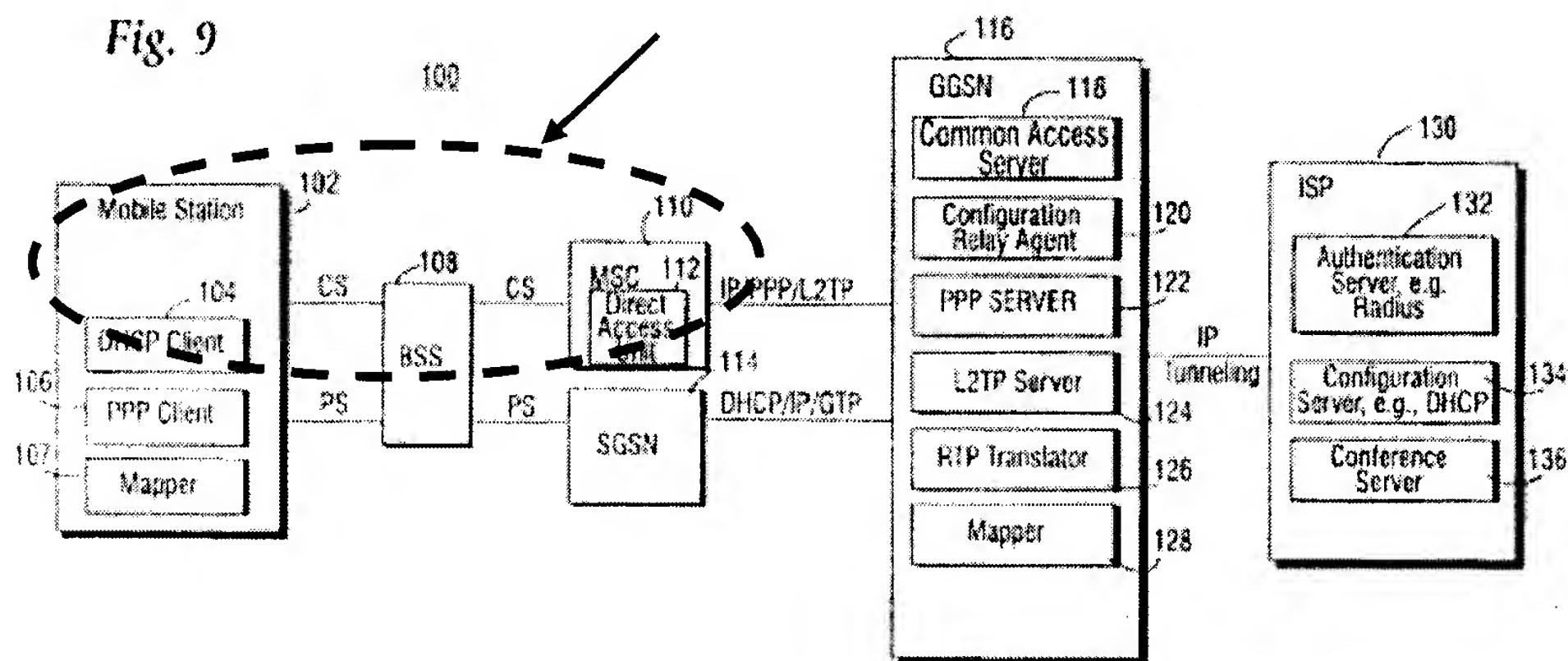
Assuming *arguendo*, that the Forslow reference discloses transferring signaling of a multimedia service via a packet connection and transferring data of the multimedia service via a circuit bearer connection as alleged in the Office Action, Forslow still does not disclose that the transfers via the network are in alignment with the standard even though the network does not support the required quality of service (QoS) functionality. As previously noted, Forslow discloses that each flow has a quality of service associated with it, and a type of bearer is selected based on the required quality of service of that particular application flow. Accordingly, Forslow’s method would select the type of bearer in the network that is best suited for the required quality of service of that particular application flow. Therefore, Forslow would be precluded from disclosing that the multimedia service is provided as specified by the standard even though the network does not support packet quality of service (QoS) functionality. As such, the rejection of claim 1 under 35 U.S.C. §102 is in clear error and should be withdrawn.

With respect to independent claim 8, the rejection of claim 8 is in clear error for at least the same reasons set forth above in claim 1. Additionally, it is respectfully submitted that Forslow does not disclose the feature of “controlling the transfer of data via the circuit bearer leg using the signaling context , wherein the signaling context is used to control the provisions of the packet-based multimedia service via the circuit bearer leg in alignment with the standard.” The Office Action points to the same passages of Forslow (See column 6 lines 34-47, column 10 lines 18-39, column 11 lines 29-42, column 11 line 56 to column 12 line 10, and Figure 7) that were used to reject claim 1, and alleges that Forslow discloses “controlling transfer of audio and video data of applications through the circuit-switched bearer service via the packet-switched bearer service to provide the application to the mobile station in alignment with the application standard.” (Final Office Action mailed January 28, 2009, pg. 6). As discussed above, Forslow provides a mechanism that selects either a circuit-switched bearer or a packet-switched bearer that is best suited to transfer an application flow in accordance with its quality of service requirements. However, Forslow is wholly silent as to using the signaling context to control the transfer of data for the multimedia service via the circuit bearer leg in alignment with the standard. As such, the rejection of claim 8 under 35 U.S.C. §102 is in clear error and should be withdrawn.

With respect to independent claim 15, the rejection of claim 15 is in clear error for at least the same reasons set forth above in claims 1 and 8. Additionally, it is respectfully submitted that Forslow does not disclose the feature of “transferring signaling for the multimedia service between the P-CSCF and the media gateway, and between the P-CSCF and the MS via the packet signaling connection in alignment with the standard.” The Office Action again points to the same passages of Forslow (See column 6 lines 34-47, column 10 lines 18-39, column 11 lines 29-42, column 11 line 56 to column 12 line 10, and Figure 7) that were used to reject claims 1 and 8, and alleges that Forslow’s BSC (Base Station Controller) acts as the claimed P-CSCF (Proxy Call Session Control Function) and Forslow’s MSC (Mobile Switching Center) acts as the claimed media gateway.” (Final Office Action mailed January 28, 2009, pgs. 7-8). If this were so, the signaling for the multimedia service would be transferred between the BSC and the MSC, and between the BSC and the mobile station (MS) via the packet signaling connection. However, this does not make sense since the path as alleged in the Office Action (MS - BSC - MSC) is a circuit-switched (CS) bearer



path as clearly shown below in Fig. 9 of Forslow. It is noted that BSS 108 in Fig. 9 is reference to a base station subsystem (BSS) which includes a base station controller (BSC). (Forslow, Col. 14, lines 35-37).



Accordingly, the rejection of claim 15 under 35 U.S.C. §102 is in clear error and should be withdrawn.

### Conclusion

It is respectfully submitted that independent claims 1, 8, and 15 and the claims that depend therefrom are in condition for allowance.

Respectfully submitted,

*Liem T. Do*

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Dated: 3-25-09

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#### Certificate of Service

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